

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Pearson et al.

Serial No.: 10/772,121

Group Art Unit: 1796

Filed: February 4, 2004

Examiner: P. Szekely

For: POLYMER BLENDS

Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

PETITION UNDER 37 C.F.R. § 1.181(a)

Applicants hereby petition the Director under 37 C.F.R. § 1.181(a) to designate the sole ground of rejection in the Examiner's Answer dated February 5, 2008, as a new ground of rejection.

The Examiner's Answer contains a rejection of claims 1, 3-33, and 68-71 under 35 U.S.C. § 103(a) as being unpatentable over a combination of 8 references: Hashimoto et al. (US 6,780,917) or Ono et al. (US 6,727,303) in view of Pierre et al. (US 2003/0109629), Pfaendner et al. (US 5,859,073), Jackson, Jr. et al. (US 4,287,325), Dickerson et al. (US 5,656,715), Jones et al. (US 6,103,857), or Jeon et al. (US 6,342,579). *Ex. Ans.* at 3.

The statement of rejection does not include two references: Strand et al. (US 5,688,899) and Shih (US 5,859,116). These references were cited or applied for the first time in the Examiner's Answer under the "Response to Argument" section. *Id.* at 5.

According to the Manual of Patent Examination Procedure, "[a] new prior art reference >applied or< cited for the first time in an examiner's answer generally will constitute a new ground of rejection." MPEP § 1207.3 at 1200-37 (Rev. 3, Aug. 2005). The MPEP also states that "[e]ven if the prior art reference is cited to support the rejection in a minor capacity, it should be positively included in the statement of rejection. *Id.* However, the MPEP notes that ">[w]here< a newly cited reference is added merely as evidence of the prior [] statement made by the examiner >as to what is "well-known" in the art which was challenged for the first time in the appeal brief<, the

citation of the reference in the examiner's answer would not >ordinarily< constitutes a new ground of rejection...." *Id.*

In this case, Strand and Shih were cited or applied for the first time in the Examiner's Answer. They were cited for the proposition that "[m]inimizing the catalyst residue is also well known." *Ex. Ans.* at 5. They were not cited in response to a statement challenged for the first time in the Appeal Brief. The Appeal Brief did not challenge any statements by the Examiner regarding what is well known in the art. Therefore, the rejection under appeal should be designated as a new ground of rejection, because the Examiner's Answer cited or applied for the first time the references to Strand and Shih.

An order to that effect is respectfully requested.

The Director is hereby authorized to charge any fees under 37 C.F.R. § 1.17 that may be required by this Petition or credit any overpayment to Deposit Account No. 05-0221.

Respectfully submitted,

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